

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action mailed September 6, 2005. At the time of the Office Action, Claims 1-4, 6-14, 16-24, 26-34, and 36-64 were pending in the Application. Applicant amends Claims 1, 7, 11, 17, 21, 27, 31, 37, 41, 44, 49, 52, 57, and 60 and cancels Claims 6, 16, 26, 36, 43, 51, and 59 without prejudice or disclaimer. The amendments and cancellations to these claims are not the result of any prior art reference and, thus, do not narrow the scope of any of the claims. Furthermore, the amendments are not related to patentability issues and only further clarify subject matter already present. All of Applicant's amendments have only been done in order to advance prosecution in this case. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Allowable Subject Matter

Applicant notes with appreciation the Examiner's allowance of Claims 47, 55, and 63. Applicant also notes with appreciation the Examiner's indication that the subject matter of Claims 8-9, 18-19, 28-29, 38-39, 45-46, 53-54, and 61-62 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. (See Pending Office Action: page 5.) Applicant has made a series of amendments to the pending claims such they now recite subject matter deemed allowable by the Examiner. For the convenience of the Examiner, Applicant also provides some discussion and further guidance as to precisely why such amendments overcome the Prior Art cited by the Examiner.

Section 103 Rejections

The Examiner rejects Claims 1, 6-7, 10-11, 16-17, 20-21, 26-27, 30-31, 36-37, and 40 under 35 U.S.C. §103(a), as being unpatentable over U.S. Publication No. 2002/0037744 issued to Bhatia et al. (hereinafter "*Bhatia*") in view of U.S. Patent No. 6,584,190 issued to Bressler (hereinafter "*Bressler*"). The Examiner rejects Claims 2-4, 12-14, 22-24, 32-34, 41-44, 48-52, 56-60, and 64 under 35 U.S.C. §103(a), as being unpatentable over *Bhatia* and *Bressler* and further in view of U.S. Publication No. 2002/0065064 issued to Griffith et al. (hereinafter "*Griffith*"). These rejections are respectfully traversed for the following reasons.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior reference (or references when combined) must teach or suggest all of the claim limitations.¹

The rejected claims are patentable over the art of record based on at least the third criterion of obviousness: none of the references alone or in combination teach, suggest, or disclose each and every claim limitation of the Independent Claims. For example, Independent Claim 1 recites “*determining allowability of the session, through an out-of-band communication, based on a service agreement without accessing external resources, the out-of-band communication comprising discovery messages.*”

Neither *Bhatia* nor *Griffith* offer any architecture that offers these out-of-band capabilities, nor do either of these references disclose the use of discovery messages. Turning to *Bressler*, *Bressler* offers an architecture for communications of telephony control signaling over data networks, but offers nothing that would inhibit the patentability of the pending subject matter. Furthermore, there is nothing in any other reference that provides this missing disclosure (i.e. out-of-band signaling with use of discovery messages). Because the references lack such limitations, Independent Claim 1 is allowable over the proposed combinations.

Independent Claims 11, 21, 31, 41, 49, and 57 recite limitations similar, but not identical, to those recited in Independent Claim 1. Therefore, these claims are also allowable, for example, for the same reasons as identified above. Additionally, the corresponding dependent claims from these Independent Claims are also patentably distinct for analogous reasons.

Accordingly, all of the pending claims have been shown to be allowable as they are patentable over the references of record. Notice to this effect is respectfully requested in the form of a full allowance of these claims.

¹ See M.P.E.P. §2142-43.

CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant believes no fee is due. If this is not correct, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact its attorney, Thomas J. Frame, at (214) 953-6675.

Respectfully submitted,
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